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10/729,184	12/04/2003	Ghislain Lefevre	1948-4826	2383

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EXAMINER	
PADGETT, MARIANNE L	
ART UNIT	**PAPER NUMBER**
1762	

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/729,184	LEFEVRE ET AL.	
	Examiner	Art Unit	
	Marianne L. Padgett	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 June 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) *7-16 and 23* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6 & 17-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. Claims 3-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The amendment filed 6/6/2000 sex is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

In claims 3-4 and in the amendments to the specification applicant has changed "embossing" or "embosses" to "granulating" or "granulations", etc., which constitutes new matter because the meaning of granulate, i.e. 24 or to crystallize into grains or granules or to collect grains or granules, etc., is entirely different meaning in embossing, which is to raise a relief from a surface, or the like. (See excerpts from Webster's Dictionary) On page 13 of their 6/6/2006 response on the first page of the remarks, applicants allege that these changes are to correct a mistranslation from the French word "grainage", however provide no support for this with respect to their specification in context therein, nor provide a certified translation or the like. Also when changes of meaning are made in the claims, they cannot help but effect of 102 or 103 issues., note that since granulation can be considered analogous to powdering, using laser radiation to granulate or powder the surface of the plastic is significantly different than embossing it, and lacking clear support for such changes, must be considered new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

2. Claims 1-6 & 21-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the context claimed in claims 3-4, granulating the plastic materials do not make much sense, since powder cannot be used to form any components of a motor vehicle indicating or lighting device as claimed, unless of course what is using it for compression molding or the like which is in no way suggested by the claims of the specification, such the at the meaning of these claims as amended is vague and indefinite. It was noted that since turning a plastic surface, which is supposed to be part of a motor vehicle indicating or lighting device into powder does not make much sense, claims 3-4 becomes fairly unexaminable.

New claims 21 & 22 are vague and indefinite, as it is noted that independent claim 1 as presently written has no necessary connection between the steps of "forming a mask or a reflector for said component..." and step of "exposing... surface is said component to laser radiation", especially considering that the mask or a reflector are formed "for" not --on-- the component, where claim 1 requires that it be the surface of the component that is exposed, and applicants appear to be claiming in claims 21 or 22 to somehow be changing some part of the mask in claim 21 (note that mask has not been positively selected from the alternatives), or in claim 22 the mask or the reflector. Also in claim 22 "... that a remainder of..." does not make sense. Should "that" be --than--? As written these new claims are too unclear to effectively or meaningfully treat with respect to the process as claimed.

The forming step in claim 1, as amended can be considered ambiguous, since it is unclear if "in a predetermined material" now refers to "a mask or a reflector", or is still supposed to be referring to "said component", as was previously claimed.

3. The other 112, second paragraph rejections in section 3 of the 12/6/2005 rejection, appear to have been adequately corrected.

4. Newly submitted claim 23 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the process of molding pairs of headlamp

reflectors is a new issue, where molding is unrelated to the processes of the already examined method claims, as this differentiation of different headlights from each other:

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 23 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

5 Claim 2-4 & 18 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

While applicant has changed the embossing of the specification to granulating, or the like, the problem as discussed in section 4 of the 12/6/2005 rejection has not been corrected because the teachings that say the plastic is not affected by the laser are not changed by whether one is embossing, i.e. using the rate laser to four raised portions or surface texturing, or whether one is using the laser to cause granulation, i.e. powdering of the substrate surface, as teachings that the laser cannot/do not affect the surface, as was previously set forth, are still in issue that was not resolved.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-2, 5-6 & 17-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 4-5 & potentially not yet entered after final claims 11-14 of copending Application No. 10/729,305. Although the conflicting claims are not identical, they are not patentably distinct from each other because as discussed in section 6 up the 12/6/2005 rejection they are of overlapping scopes with the present claims reciting metallization in the dependent claims instead of the independent claim(s), and the preamble attributing and "optical function" to the component as claimed in both cases, whereas the (305) application claims a decorative motif, which is considered to be of overlapping scope, as all coatings or treatments that have a visible

effect have in essence an optical function, i.e. something that is opaque has the optical function of blocking light, while transparent as the optical function of passing light, with translucent or the like that is colored or patterned may affect the quality of light, etc., hence the (305) pre-and application is an obvious variation of the present application that is slightly narrower, so would have been obvious to one of ordinary skill in the art.

This rejection does not appear to have been contested for reason of contents of its claims, but for the entirely on appropriate reason that they are filed on the same date. As this makes them copending, rejection in view of obviously double patenting remains appropriate, as long as both patents do not have allowable claims and have not been adequately differentiated

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 1-2, 5-6 & 17-20 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Shaffer et al. (5,817,243), as discussed in section 7 of the 12/6/2005 rejection.

With respect to Shaffer et al., applicants argue about the effects of the references laser etching, however applicants claims do not require any specific affect, but merely that components that might be used for indicators are lighting devices (which are taught by this reference) must be exposed, with no requirement for there to be any effect what so ever in claims 1-2. Applicant express concern about whether or not plastic is affected, while none of their claims treated in this rejection require any plastic to be treated, hence applicant's arguments are not commensurate in scope to the claims to which they are applied.

To reiterate, Shaffer et al. teach creating decorative contrast designs on motorcycle and automobile parts, that employ a laser scanning process with pulsed lasers, such as YAG, CO_2 and excimer lasers, where the parts to be treated include molded translucent or transparent plastic substrates that are for automobile or motorcycle light globes and lenses, or mirrored glass, etc. It is taught that parts may be

directly etched or plated with metal and then laser ablated to affect taught designs. Note that such designs will have masking effects, and since applicants' masks are not used for anything in particular or connected to the laser process, they do not provide distinction. See the abstract; figure 1; col. 1, line 6-15 & 35-63; col. 2, lines 8-36; col. 3, line 63-col. 4, lines 1-34, 43-53 & 61-67; col. 5, lines 1-14; examples on col. 6-8, especially example 1, 3 & 5.

9. Claims 1, 6 & 17-18 are rejected under under 35 U.S.C. 103(a) as obvious over Pyburn et al. (5,614,338), discussed in section 8 of the 12/6/2005 rejection.

Applicants have amended independent claims 1 & 17 to require that the indicating are lighting devices emit a beam of light, on while it is possible that the backlit graphics and illuminated displays of the automobile instrument panels may have features that can be considered to even it beams of light at various points on the panel, they do not necessarily do so, but whether they like emitted is a being or some broader display is a matter of design of the individual panel, hence would've been highly dependent on design choice and the like. It is noted that applicants' discussion concerning masks or reflectors are do not remove the rejection to claim 1 and its dependence, since the backlighting pattering form can be considered a type of masking, and applicants claims have not distinguished how the masking is employed in the process in a way that distinguishes from this reference.

To reiterate, Pyburn et al. teach making a graphic for a backlit component, such as a button for an illuminated graphic display of an automobile instrument panel, where it is noted that such a device reads on both the claimed indicating and claimed lighting device options for motor vehicles in applicants' claims. Pyburn et al. uses laser irradiation (YAG, CO_2) to produce substantially opaque regions in transparent polymeric material due to reaction of the laser energy with pigment present therein, thus producing a pattern with areas of different optical function. It is also taught that the laser may rough in the surface under some circumstances, which reads on a type of texturing. In Pyburn et al., see the

abstract; figures; col. 1, lines 5-20; col. 2, lines 38-67; col. 3, line 61-col. 4, line 68+, especially 20-37 & 62-65 (roughing).

10. Claims 1-2, 5-6 & 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai (5,911,317), in view of Pyburn et al. (discussed above in section 9).

The above arguments in section 9 also apply to the maintenance of these rejections.

To reiterate from section 9 of the 12/6/2005 rejection, Tsai teaches a technique for making a light permeable metal plated rubber key that is taught to be useful in all kinds of electronic and telecommunication products. The key has a silicone rubber base with a layer of ink in a desired color and a protective resin layer thereover, which is then vacuum spray plated with a metal such as Ni, Cr, Ti, Al, Cu, Sn, Ag or Au, to completely metallize, that is subsequently laser engraved, i.e. laser ablated, to display a desired letter, and finely protectively coated. In Tsai, see the abstract; figures; col. 1, line 7-11; col. 2, lines 8-40.

Tsai does not mention the use of their key, i.e. button, in any kind of motor vehicle, however motor vehicles instrument panels are replete with various electronics and controls therefore, hence as such it would have been obvious to one of ordinary skill in the art to use the keys or buttons of Tsai for such electronics in automobiles that require buttons, especially in view of Pyburn et al., who teach and demonstrates the use of backlit buttons in automobile instrument panels, providing further motivation for the above stated obviousness.

11. With respect to Shizuku Hideji (JP 2000-176659, Derwent & JPO abstracts + machine translation), discussed in section 10 of the 12/6/2005 rejection the rejection over claims 1-2, 5-6 & 17-20 has been removed.

A formal translation of this reference has now been received, and is supplied with this action. Note paragraph [0001] relates to buttons used for cars, [0002] Notes prior art teachings of characters on buttons, etc. trimmed by YAG lasers; [0005] discusses of aspiration deposition and laser trimming to

achieve drawings of characters, numerals, marks & patterns, etc., however while the teachings of this Japanese reference provide for making indicator buttons for cars, they do not discuss backlighting use therefore, hence there is no suggestion in the reference of a meeting light or a beam of light, hence the amendments overcome this rejection

As noted in previous be cited abstract machine translation, these Japanese reference teaches thermocompression bonding or hot stamping of metal foil onto a plastic or glass substrate base, where the metal is then patterned the laser marking such that the laser evaporates or scatters metal from the metal layer in order to draw a character, number, mark, pattern, etc., therein. YAG lasers are taught for use in this patterning process, and end uses include use for buttons in motor vehicles, portable telephones, etc., thus reading on the claimed indicating devices for mobile vehicles. Particularly seat the two English abstracts and paragraphs [0001], [0005-6]. As the quality of the new sheen translation is poor with untranslated words, a formal translation has been ordered, but not yet received.

12. Tentatively, Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al. as applied to claims 1-2, 5-6 & 17-20 above, and further in view of Pope (GB 2244934 A) or Ouderkirk et al. (2004/0145289 A1), as discussed in section 11 of the 12/6/2005 rejection.

This rejection is being maintained, as applicants appear to have stated that the changing of embossing to granulating does not affect 102 or 103 rejections (page 13 on first page remarks), and because if applicants really meant granulating, i.e. turning into powder claims 3-4 with make absolutely no sense.

It is noted that with respect to Ouderkirk et al, applicants' arguments that the French patent application antedates Ouderkirk et al is not supported by a certified translation, hence until such as is supplied & verified as being consistent with the English language application submitted for examination, the French application cannot be used to remove Ouderkirk et al as prior art.

To reiterate, while Shaffer et al. teach laser etching or ablation of either the glass or plastic substrate material, or of metal plated on substrate material for automobile parts, or teach discoloring lenses or globes for automobile lights to create patterns within the substrate, they do not teach "laser embossing", unless by laser embossing applicant actually been laser etching, in which case claimed 3 belongs in the 102 rejection, however embossing in general does not mean taking away of material, as seated beside a dictionary definition.

Ouderkirk et al. teach multilayer reflectors that are placed in front of light sources, that are made of polymeric materials, which may have nonuniform thickness or thickness gradients along its length and/or width that have been produced via thermoforming, embossing, laser embossing, etc., that are taught to be advantageous as the variation in thickness produced, potentially by laser embossing, reduces an undesirable "halo effect" (figure 13, [0089-93]), which would have been relevant to automobile lights. Therefore, it would have been obvious to one of ordinary skill in the art, given Shaffer et al.'s laser treated globes and lenses that may be textured or patterned, to treat them with the laser embossing as suggested by Ouderkirk et al. to effect a gradient thickness reflective layer in order to reduce halo effects on the automobile lights.

Alternately, Pope teaches embossing holograms possibly by laser embossing in plastic substrates, where the hologram may be a reflection hologram, i.e. metallized, hence it would have been obvious to one of ordinary skill in the art given that Shaffer et al. teach the desirability of laser etching or drawing figures into the material of the light globes and lenses of automobiles, to make those figures holographic laser embossed figures due to the desirable and dramatic aesthetic effects as taught for holographic patterns therein. See the abstract; page 1, lines 8-23; page 3, lines 9-16 & 21-page 4, line 6.

13. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shizuku Hideji, or Tsai (5,911,317) in view of Pyburn et al, as applied to claims 1-2, 5-6 & 17-20 above, and further in view of Weber et al. (2001/0019013 A1), as discussed in section 12 of the 12/6/2005 rejection.

The remarks in section 12 above are also relevant here.

To reiterate, the art of the above-discussed rejections do not employ laser embossing, however Weber et al. shows that analogous buttons or keys or switches (which can be used to turn on headlights) that are to have symbol displayed on them, may have that symbol embossed where lasers may have been employed, hence it would have been obvious to one of ordinary skill in the art that any of the symbols as created on buttons/keys from the above rejections could have been additionally distinguished by raising of the area to be patterned via laser embossing, providing a laser capable of interacting with the polymeric material of the button/key was employed, thereafter the succeeding metallizing patterning steps could proceed as taught, since the patterning techniques would have been complementary to each other, providing care was taken in selection of laser wavelengths for the two different techniques or materials to enable the effects.

14. Applicant's arguments filed 6/6/2006 and discussed above have been fully considered but they are not persuasive.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne L. Padgett whose telephone number is (571) 272-1425. The examiner can normally be reached on M-F from about 8:30 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks, can be reached at (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MLP/dictation software

8/21/2006

MARIANNE PADGETT
PRIMARY EXAMINER